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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,157	09/09/2003	Jurgen Schroder	242611US0	1033
22850	7590	08/03/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SOLOLA, TAOFIQ A	
		ART UNIT	PAPER NUMBER	
		1626		

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/657,157	SCHRODER, JURGEN	
	Examiner Taofiq A. Solola	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

Claims 1-7 are pending in this application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2 are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with errors, rendering them unclear and confusing. For example, the phraseology "less than 250 g/h and liter of reactor volume", line 4, claim 1, is confusing. Claim 2 appears to be a duplicate of claim 1. Therefore claims 1-7 are indefinite. Appropriate correction is required.

Claims 3 and 5 are multiple and improper dependent claims. Claim 3 is not in the alternative and claim 5 depends from other multiple dependent claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tweedy, US 6,175,037 B1, and Trapasso et al., 5,555,785, individually.

Applicant claims a process for making meth-acrylic esters comprising esterifying meth-acrylic acid or transesterifying meth-acrylic esters with alcohol, optionally in the presence of 0.2 mmol polymerization inhibitor, and optionally heating the alcohol without water prior to the reaction. In preferred embodiments, 0.1 meq/kg of the alcohol peroxide is used, the alcohol is mono- or poly-hydroxy having between C1-C12 atoms. Applicant also claims generic compounds as stabilizers and phenothiazine as polymerization inhibitor.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Tweedy teaches a process of making meth-acrylic esters comprising esterifying meth-acrylic acid with mono- or poly-hydroxy alcohol in the presence of a polymerization inhibitor. Tweedy teaches several specific alcohols and inhibitors. See columns 1-7. Trapasso et al., teach a process of making meth-acrylic esters comprising transesterifying meth-acrylic esters with mono- or poly-hydroxy alcohol having between C3-C26 atoms in the presence of polymerization inhibitor. Trapasso et al., teach several specific examples of applicable alcohols and inhibitors. See columns 1-8 and the examples.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the instant invention and that of Tweedy is that Tweedy does not teach transesterification and Trapasso et al., do not teach direct esterification while applicant claims both processes. Also neither reference teaches phenothiazine as an inhibitor.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142.2413)*

However, phenothiazine is well known in the art as a polymerization inhibitor. For example, see attached translated abstracts of Martin et al., WO 2003042151 A1, and Nestler et al., DE 10127941 A1. Claiming 0.2 mmol. polymerization inhibitor, and 0.1 meq/kg of the

alcohol peroxide as well as alcohol having between C1-C12 atoms are options available to a practicing artisan. The claimed alcoholic range is close enough to that of Trapasso et al., such that expected result would have been *prima facie* obvious from the prior art. *In re Titanium metals Corp. v Banner*, 778 F.2d 775 (Fed. Cir. 1985). 0.2 mmol. of inhibitor and 0.1 meq/kg of alcohol peroxide are mere optimization of variables, and are unpatentable absent unexpected result, which is different in kind not merely in degrees from the prior art. *In re Aller*, 22 F.2d 454 (CCPA, 1955).

Therefore, the instant invention is *prima facie* obvious from the teachings of Tweedy and Trapasso et al. One of ordinary skill in the art would have known to claim both procedures using phenothiazine as a polymerization inhibitor at the time the invention was made. The motivation is from the success of the prior arts in performing the procedures.

### ***Specification***

The specification is generally narrative and indefinite, failing to conform to current U.S. practice. It appears to be a literal translation into English from a foreign document and are replete with errors, rendering them unclear and confusing. For example, on page 11, line 9, "A 11 four-neck" is recited and elsewhere in the specification. Appropriate correction is required.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



TAOFIQ SOLOLA  
**PRIMARY EXAMINER**  
Group 1626

July 28, 2004